<u>REMARKS</u>

This is in full and timely response to the non-final Official Action of March 4, 2009. Reexamination in light of the following remarks is respectfully requested.   No new matter has been added. Claims 3-5 and 8-16 are currently pending in this application, with claims 3-5 and 8-13 being independent.

I. Claim Rejections – 35 U.S.C. §112

Claims 3-5 and 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that in all claims, the terms "read-in" and/or "reading-in" are vague and indefinite. The rejection is respectfully traversed for reasons set forth below.

By the foregoing amendment, all the rejected claims have been amended to cancel the terms. Withdrawal of the rejection is respectfully requested.

IV. Claim Rejections – 35 U.S.C. §101

1. Claims 8-13

Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Office Action asserts that claims 8-10 recites a device, however, the "reader", "analyzer" and "calculator" as written, are considered to be software per se and not parts of a device or machine.

By the foregoing amendment, claims 8-10 have been amended to recite parts or machine as to be directed to statutory subject matter. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

2. Claims 11 and 12

As to claims 11 and 12, the Office Action asserts that in order for a method to be considered a "process" under §101, a claimed process must either (1) be tied to another statutory class such as a particular machine that imposes meaningful limits on the method claim's scope or (2) transform underlying subject matter (such as an article or materials). Specifically, the Office Action asserts that in claims 11 and 12, the computer is merely mentioned in the preamble, and it must be positively recited in the body of the claim showing its significant function in the invention.

By the foregoing amendment, the "computer" is recited in the body of the claims. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

III. Claim Rejections – 35 U.S.C. §103

Claims 3-5 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney et al., U.S. Patent Number 6,556,992 B1. The rejection is respectfully traversed for reasons set forth below.

1. Claims 3, 8 and 11

(1) Claim 3

Claim 3 is directed to a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of analyzing a specification, so as to obtain a number of words for preferred embodiment and a number of words of claims; a patent value calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}; and a patent value output step of outputting said patent value.

Barney arguably teaches a method and a system for valuing patents. As admitted in the Office Action of March 4, 2009, the applied art fails to disclose, teach or suggest "a patent value

calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}." However, the Office Action asserts that "Barney suggests a word density ratio (e.g., different-words/total-words), and it would have been obvious to one of ordinary skill in the art at the time of the invention to use different ratios in order to be able to provide a comprehensive quantifiable analysis."

The assertion is based on a hindsight, or is not supported by any basis. According to the formula of the claimed invention, it is possible to know how in detail the claimed inventions are described in the specification. (In the claimed invention, information as to how many times the description in the specification is larger than that of the claims is obtained from a patent value calculated by using the formula {the number of words for preferred embodiment/the number of words for claims}. On the other hand, in Barney, no information about relation between the claims and preferred embodiment can be obtained since Barney merely teaches the word density ration (different-words/total-words).

In addition, a value obtained from the word density ratio (e.g., different-words/total-words) according to Barney depends on how many homonymous words or phrases are in the specification. For example, a large value is obtained from the word density ratio of Barney, when many different homonymous words and/or phrases are used in a specification, while a small value may be obtained from the word density ratio when many homonymous words and/or phrases are not used in the same specification.

Thus, Applicant believes that the word density ratio is not correlated with the claimed formula {the number of words for preferred embodiment/the number of words for claims}.

Therefore, Barney fails to disclose, teach or suggest "a patent value calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}."

Moreover, Applicant believes that when the present invention was made, a patent value was not evaluated based on the claimed formula: {the number of words for preferred embodiment/the number of words for claims}. Moreover, the patent value based on the claimed formula was not predictable when the invention was made. Thus, the Office Action fails to provide some articulated reasoning to support the legal conclusion of obviousness.

Please note that rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

MPEP § 2141 III states as follows:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" KSR, 550 U.S. at ___, 82 USPQ2d at 1396. (Emphasis added.)

As stated above, the applied art fails to disclose, teach or suggest "a patent value calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}." Further, the Office Action states a mere conclusory statement of rejection, and no articulation of the reasoning with some rational underpinning to support the legal conclusion of obviousness. Thus, a prima facie case of obviousness has not been met. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

If the Examiner maintains the assertion without additional evidence, the Examiner takes Official Notice since no evidence has been provided to show that it would have been obvious to one of ordinary skill in the art at the time of the invention to use <u>the formula recited in the claim</u> in order to be able to provide a patent value. The Applicant respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

(2) Claim 8

Claim 8 is directed to a data processing device comprising: a MPU including a specification analyzer for analyzing a specification and a patent value calculator for calculating a patent value based on the following formula: {a number of words for preferred embodiment/number of words for claims}; and a printer or a display for outputting said patent value.

The applied art fails to disclose, teach or suggest "a patent value calculator for calculating a patent value based on the following formula: {a number of words for preferred embodiment/number of words for claims}."

Since the Office Action makes a mere conclusory statement of rejection and no articulation of the reasoning with some rational underpinning to support the legal conclusion of obviousness, a prima facie case of obviousness has not been met. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

(3) Claim 11

Claim 11 is directed to a method implemented by a computer comprising the following steps of: a specification analysis step of analyzing said specification in the computer, so as to obtain a number of words for preferred embodiment and a number of words of claims; a patent value calculation step of calculating a patent value using the following formula in the computer: {the number of words for preferred embodiment/the number of words for claims}; and a patent value output step of outputting said patent value.

As discussed above, the applied art fails to disclose, teach or suggest "a patent value calculator for calculating a patent value based on the following formula: {a number of words for preferred embodiment/number of words for claims}."

Since the Office Action makes a mere conclusory statement of rejection and no articulation of the reasoning with some rational underpinning to support the legal conclusion of obviousness, a prima facie case of obviousness has not been met. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

2. Claim 4, 9 and 12

(1) Claim 4

Claim 4 is directed to a program product stored in a computer readable medium that permits a computer to implement the following steps of: an element obtaining step of obtaining elements based on a specific letter string in a specification; a specification analysis step of analyzing said specification so as to obtain the smallest number of elements composing one claim; a patent value calculation step of calculating a patent value using the smallest number of the elements composing one claim obtained by the specification analysis step, as a parameter; and a patent value output step of outputting said patent value.

The Office Action asserts that Barney discloses counting the number of elements in claims such that <u>elements are words</u>. However, in Barney, the elements are merely words, and elements are not identified based on a specific letter string. Thus, the applied art fails to disclose, teach or suggest "an element obtaining step of obtaining elements based on a specific letter string in the specification data."

Therefore, Applicant believes that claim 4 is patentable over the applied art. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

(2) Claim 9

Claim 9 is directed to a data processing device comprising: a MPU including an element obtaining means for obtaining elements based on a specific letter string, a specification analyzer for analyzing a specification so as to obtain a smallest number of elements composing one claim and a patent value calculator for calculating a patent value using the smallest number of elements composing one claim obtained in the specification analyzer, as a parameter; and a printer or display for outputting said patent value.

The Office Action asserts that Barney discloses counting the number of elements in claims such that <u>elements are words</u>. However, as discussed above, in Barney, the elements are merely words and elements are not identified based on a specific letter string. Thus, the applied art fails to disclose, teach or suggest "an element obtaining means for obtaining elements <u>based on a specific letter string</u>."

Thus, claim 9 is patentable over the applied art. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

(3) Claim 12

Claim 12 is directed to a method implemented by a computer comprising the following steps of: an element obtaining step of obtaining element based on a specific letter string by the computer; a specification analysis step of analyzing said specification by the computer so as to obtain the smallest number of elements composing one claim; a patent value calculation step of calculating a patent value using the smallest number of elements composing one claim obtained in the specification analysis step carried out in the computer, as a parameter; and a patent value output step of outputting said patent value from the computer.

The Office Action asserts that Barney discloses counting the number of elements in claims such that elements are words. However, as discussed above, in Barney, the elements are merely words and elements are not identified based on the specific letter string. Thus, the applied art

fails to disclose, teach or suggest "an element obtaining step of obtaining element based on a specific letter string by the computer."

Thus, claim 12 is patentable over the applied art. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

3. Claim 5, 10 and 13

(1) Claim 5

Claim 5 is directed to a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of analyzing a specification so as to obtain a depth of claim nesting level; a patent value calculation step of calculating a patent value using the depth of claim nesting level or the number of claim categories obtained in said specification analysis step, as a parameter; and a patent value output step of outputting said patent value.

The Office Action asserts that Barney teaches "a depth of claim nesting level." However, nowhere does Barney teach "a depth of claim nesting level." Thus, the applied art fails to disclose, teach or suggest "analyzing said specification data so as to obtain a depth of claim nesting level." Moreover, Applicant believes that the patent value based on the depth of claim nesting level was not predictable when the invention was made.

Therefore, claim 5 is patentable over the applied art. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

(2) Claim 10

Claim 10 is directed to a data processing device comprising: a specification analyzer for analyzing a specification so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculator for calculating a patent value using the depth of claim nesting

level obtained in the specification analyzer, as a parameter; and a patent value output means for outputting said patent value.

The Office Action asserts that Barney teaches "a depth of claim nesting level." However, nowhere does Barney teach "a depth of claim nesting level." Thus, the applied art fails to disclose, teach or suggest "analyzing a specification so as to obtain <u>a depth of claim nesting level</u>." Moreover, Applicant believes that the patent value based on the depth of claim nesting level was not predictable when the invention was made.

Therefore, claim 10 is patentable over the applied art. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

(3) Claim 13

Claim 13 is directed to a method implemented by a computer comprising the following steps of: a specification analysis step of analyzing a specification in the computer so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculation step of calculating a patent value using the depth of claim nesting level obtained in said specification analysis step carried out by the computer, as a parameter; and a patent value output step of outputting said patent value from the computer.

The Office Action asserts that Barney teaches "a depth of claim nesting level." However, nowhere does Barney teach "a depth of claim nesting level." Thus, the applied art fails to disclose, teach or suggest "a specification analysis step of analyzing a specification in the computer so as to obtain a depth of claim nesting level." Moreover, Applicant believes that the patent value based on the depth of claim nesting level was not predictable when the invention was made.

Therefore, claim 13 is patentable over the applied art. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

IV. Newly Added Claims

By the foregoing amendment, Applicant has added claims 14-16 in order to claim various features of the invention. Since claims 14-16 depend on base claim 5, 10, 13 respectively, they are allowable for at least same reasons that the respective claims are allowable.

V. Conclusion

In view of the following arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. **Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.** Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. IRD-0002 from which the undersigned is authorized to draw.

Dated: May 1, 2009   Respectfully submitted,

                                    By   /Toshikatsu Imaizumi/
                                          Toshikatsu Imaizumi, Reg. 61,648
                                          RADER, FISHMAN & GRAUER PLLC
                                           Correspondence Customer Number: 23353
                                           Attorney for Applicant